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IN THE UNITED STATES PATENT OFFICE

5 *Ex parte* Stephen M. REUNING
Serial No. 09/897,826
Filing Date: 03 July 2001

Appeal No. : 2004-1714

10 Rule 197(b)
REQUEST FOR REHEARING

15 Honorable Commissioner for Patents
Post Office Box 1450
Mail Stop - Board of Patent Appeals
Alexandria, VA 20231

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RULE 197(B) REQUEST FOR REHEARING

25 This REQUEST FOR REHEARING is submitted in response to the DECISION ON APPEAL (30 Sept 2004). This paper is due within two months of the mailing date of the DECISION ON APPEAL; this paper is thus believed timely filed. No fee is believed required.

GROUNDS UPON WHICH REHEARING IS SOUGHT

30 Applicant respectfully believes the Board has failed to fully understand the agency's previous administrative fact findings. Applicant senses that this error may simply be due to the Office's failure to forward to the Board the complete prosecution history, including a copy of the parent application file, Serial No. 08/984,650.

35 The immediate case recites claims copied from the parent application. In the parent case, the Examiner accepted Applicant's RULE 132 DECLARATION to antedate the MCGOVERN reference. In the immediate case, however, the Examiner refuses to accept the same DECLARATION, to antedate the same reference, for the same claims.

Ex parte Stephen M. REUNING
Serial No. 09/897,826
Art Unit 2175
Examiner Samuel RIMELL, Esq.

POINTS OF LAW OR FACT OVERLOOKED OR MISAPPREHENDED

The DECISION ON APPEAL correctly notes that "the claims on appeal are different from the claims allowed in the parent application." See DECISION ON APPEAL at 3.

5 This is incorrect. The claims on appeal are different from those recited included in the published issued parent patent. The parent application, however, included additional claims found allowable by the Office. After the Office confirmed the patentability of this subject matter, these claims were deleted from the parent and filed in the immediate case, based on the Examiner's representation that these claims would be promptly allowed.

10 The DECISION ON APPEAL also misapprehends the content of MCGOVERN, because the DECISION contradicts the agency's administrative factual findings that MCGOVERN fails to each claim element.

The DECISION accurately summarizes the claimed invention as a system for locating an individual with specifically defined professional qualifications. See DECISION at 1. The

15 DECISION accurately summarizes the claimed invention:

20 1. A system for locating an individual with specifically defined professional qualifications, the system comprising: a. a filter that can search a web page to identify in said web page the presence or absence of specifically defined professional qualifications, and b. an e-mail address extractor that can extract an e-mail address from said web page.

Thus, application claim 1 entails using specifically defined criteria to filter web pages, and then extracting email addresses from them. The parent application recited similar application claims.

For example, parent application claim 18 claims:

25 18. A computer implemented method comprising: a. locating an Internet site page or web posting which contains operator specified text comprising specifically defined experiences ...; b. extracting from said Internet site page or web posting an email address; and c. sending an electronic mail message to said extracted address.

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Art Unit 2175
Examiner Samuel RIMELL, Esq.

See AMENDMENT IN SERIAL NO. 08/984,650 at 4-5 (15 Feb. 2000). Thus, parent application claim 18, like the immediate application claim 1, entails using specifically defined criteria to filter web pages, and then extracting email addresses from them.¹

In the parent case, parent application claim 18 was rejected as obvious over MCGOVERN. See OFFICE ACTION at 4-6 (1 May 2000).

In response, Applicant submitted a RULE 132 DECLARATION (14 July 2000). In response, the Office withdrew the obviousness rejection over MCGOVERN and conceded that claim 18 is patentable. See *e.g.*, OFFICE ACTION at 2 (24 Aug. 2000).

In response to the 1 May 2000 obviousness rejection over MCGOVERN, Applicant also explained that "McGovern does not disclose a system involving getting an e-mail address — by extraction or otherwise — from an Internet page or web posting; McGovern's e-mail addresses need to be individually sent to or input into the system." See AMENDMENT at 6-7 (14 July 2000) (emphasis in original). In response, the Office withdrew the rejection based on MCGOVERN and conceded that claim 18 is patentable. See *e.g.*, OFFICE ACTION at 2 (24 Aug. 2000).

The Office made an express written finding that claim 18 is patentable (in fact, the Office reiterated this finding more than once). The Office has found that "comparing text against professional qualifications and electronically extracting e-mail addresses when those qualifications are met" is a novel, non-obvious combination. Based on the Office's written fact finding, Applicant filed the immediate application. Having made this fact finding, and having represented to Applicant *in writing* that the immediate subject matter is patentable, the Board should not condone the Examiner's arbitrary and capricious change in position.

¹ N.B.: Parent application claim No.18 also includes a third step: sending an email. It might have been argued that this third step differentiates the two claims, making the Applicant's Declaration applicable to one, but not the other. The Office, however, specifically rejected this argument, finding, to the contrary, that extracting an email address inherently includes sending an email as a mere obvious variant thereof. The Office has therefore found step c. not material.

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SUMMARY

The DECISION ON APPEAL (30 Sept 2004) relies on factual assumptions which are directly contradicted by the agency's prior administrative fact findings. MCGOVERN fails to include each claim element, and MCGOVERN must be withdrawn as a reference because the Office has previously concluded that Applicant antedates it.

Respectfully submitted,

J. Mark Pohl
Pharmaceutical Patent Attorneys, LLC
55 Madison Avenue, 4th floor
Attention : Mark POHL (P 4014)
Morristown, NJ 07960-7397 U.S.A.
23 November 2004

Mark POHL, Reg. No. 35,325
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mbc:mp

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APPEAL RECONSIDERATION Page 4

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,826	07/03/2001	Stephen Michael Reuning	Diedre/Candidate	2051
22925	7590	01/25/2005		
PHARMACEUTICAL PATENT ATTORNEYS, LLC				
55 MADISON AVENUE				
4TH FLOOR				
MORRISTOWN, NJ 07960-7397				
			EXAMINER	
			KIMELL, SAMUEL G	
		ART UNIT	PAPER NUMBER	
		2165		

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of Abandonment

Application No.

09/897,826

Applicant(s)

REUNING, STEPHEN
MICHAEL

Examiner

Sam Rimell

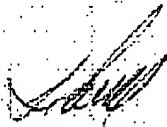
Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☐ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$ _____ is insufficient. A balance of \$ _____ is due.
The issue fee required by 37 CFR 1.18 is \$ _____. The publication fee, if required by 37 CFR 1.18(d), is \$ _____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37):
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.31(a)) upon the filing of a continuing application.
6. ☒ The decision by the Board of Patent Appeals and Interference rendered on 9/30/04 and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


 Sam Rimell
 Primary Examiner
 Art Unit: 2165

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

U.S. Patent and Trademark Office
 PTOL-1432 (Rev. 04-01)

Notice of Abandonment

Part of Paper No. 20050403

fax (571) 273-0101

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JUL 27 2005

Inventor : Stephen M. REUNING
Serial No. : 09/897,826
Filing Date : 03 July 01
Title : Candidate Chaser
Group Art : 2175
Examiner : ~~Laufer, S.P.B.~~ VINCENT TRANS, SPE

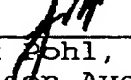
Technology Center 2100

STATEMENT OF PERSONAL KNOWLEDGEUnder Rule 8(b)(3)

On 23 November 2004, I filed a Rule 97(b) REQUEST FOR REHEARING in this case. This request is belicved timely filed, because it was filed within two months of the mailing date of the Board's decision. Per the Board's instruction, I submitted this by facsimile to the Board at 703-308-7952. Per Rule 1.8, I accompanied this with a Certificate of Facsimile Transmission.

I state the above based on my own personal knowledge.

Respectfully submitted,

/s/ 
By Mark Pohl, Reg. No. 35,325
55 Madison Avenue, 4th floor
Morristown, NJ 07960-7397

27 July 2005

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEB 03 2005

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/897,826
	Filing Date	3 July 2001
	First Named Inventor	REUNING
	Group Art Unit	Board of Appeals
	Examiner Name	RIMMEL
Total Number of Pages in This Submission	Attorney Docket Number	Diedre

ENCLOSURES <i>(check all that apply)</i>		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts / Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Request for Rehearing
Remarks: On 23 Nov 04, I filed a Request for Reconsideration with the Board (copy enclosed). I just received a Notice of Abandonment (copy enclosed). Could you please withdraw the Notice of Abandonment and provide a response to the Request for Reconsideration. MANY thanks,		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Pharmaceutical Patent Attorneys, LLC 55 Madison Avenue, 4th floor, Morristown NJ 07960-7397 USA
Signature	<i>[Signature]</i>
Date	See below date

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: FEB 03 2005	
Typed or printed name	Mark POHL, Reg. No. 35,325
Signature	<i>[Signature]</i>
Date	3 Feb 05

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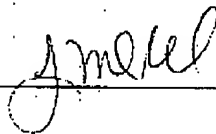
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on 3 Feb 05

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Mark POILL, Reg. No. 35,325

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The submitted papers are enumerated on the enclosed Transmittal Form,
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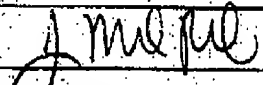
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TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/897,826
	Filing Date	3 July 2001
	First Named Inventor	Stephen M. REUNING
	Group Art Unit	2175
	Examiner Name	Samuel RIMELL, Esq.
Total Number of Pages in This Submission	Attorney Docket Number	Diedre Moire Corp.

ENCLOSURES <i>(check all that apply)</i>		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks: Enclosed find a Request for Rehearing under Rule 197(b). No fee is enclosed, because none is believed required.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Pharmaceutical Patent Attorneys, LLC 55 Madison Avenue, 4th floor, Morristown NJ 07960-7397 USA
Signature	
Date	See below date

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: _____	
Typed or printed name	Mark FOHL, Reg. No. 35,325
Signature	Date 23 Nov 04

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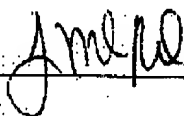
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